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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/708,799

03/26/2004

Wei-Guan YAU

MTKP0150USA

2798

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11/14/2006

NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION
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MERRIFIELD, VA 22116

EXAMINER

WEST, JEFFREY R

ART UNIT

PAPER NUMBER

2857

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/708,799

Applicant(s)

YAU, WEI-GUAN

Examiner

Jeffrey R. West

Art Unit

2857

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,3-6,9,11-13,15-23,26 and 28-34.
Claim(s) withdrawn from consideration: 7,8,10,24,25 and 27.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See continuation sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


EXAMINER - 2857

Applicant's proposed amendments to independent claims 1 and 13 would be suitable to overcome the outstanding 35 U.S.C. 101 rejections.

In response to Applicant's argument that the combination of Kawai in view of Progar is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, the Examiner maintains that the combination is not based on information gleaned from Applicant's disclosure and that the motivation is based on the knowledge of one having ordinary skill in the art and the references themselves, specifically, it would have been obvious to one having ordinary skill in the art to modify the invention of Kawai to specify that the actual time interval between each of the reference events is used to calculate a plurality of compensation values, each compensation value corresponding to the predetermined time interval and one of the actual time intervals, as taught by Progar, because while the invention of Kawai only calculates one compensation value thereby only correcting the associated reference event count once, the combination, as suggested by Progar, would have improved the invention of Kawai by providing repeated updating of the count value to provide increased and continuous accuracy, while also allowing more precise updating and overall operational efficiency through the determination and accumulation of fraction error values over user desired time intervals (column 1, lines 41-53, column 5, lines 1-17 and column 5, line 59 to column 6, line 4).

Applicant argues, "if modified according to the motivation of the Examiner quoted above, the Kawai reference would need to be modified to no longer perform the two step calibration method as taught. In fact, no calibration would be required whatsoever. That is because the Examiner is stating that a person skilled in the art would be motivated by Progar to modify the Kawai system to no longer calibrate the second basic clock signal in a first stage but to instead simultaneously utilize both the first and the second basic clock signals while the system is in operation..."


The Examiner asserts that the proposed modification to specify that the actual time interval between each of the reference events is used to calculate a plurality of compensation values would not eliminate the calibration. Instead, since the invention of Kawai already discloses utilizing a compensation value for reducing a difference between the count value and the threshold value (column 10, lines 4-22), the combination would perform the calibration more frequently rather than eliminate the calibration.

In response to Applicant's argument that the combination of Chapman in view of Progar is based upon improper hindsight reasoning, the Examiner maintains that the combination is not based on information gleaned from Applicant's disclosure and that the motivation is based on the knowledge of one having ordinary skill in the art and the references themselves, specifically, it would have been obvious to one having ordinary skill in the art to modify the invention of Chapman to explicitly indicate that the count value is updated according to a value being dynamically calculated by accumulating a plurality of actual time intervals, as taught by Progar, because while the invention of Chapman calculates one compensation value thereby only correcting the associated reference event count once, the combination, as suggested by Progar, would have improved the invention of Chapman by providing repeated updating of the count value to provide increased and continuous accuracy, while also allowing more precise updating and overall operational efficiency through the determination and accumulation of fraction error values over user desired time intervals (column 1, lines 41-53, column 5, lines 1-17 and column 5, line 59 to column 6, line 4).

Applicant argues, "such a motivation directly conflicts with the teachings of Chapman in col 2, lines 16-21 stating, 'Furthermore, the calibrations required to apply error correction to the programmable register value and the need to correct for inaccuracies each and every second increases the processor overhead associated with use of the Luitje technique to an undesirable level.'"

The Examiner asserts that the advantage of Chapman over the significant processor overhead is due to the correction factor determination being automated and integrated with the normal production testing and not required to be corrected each and every second (Chapman; column 2, lines 3-21 and column 6, lines 39-48). The proposed modification to Chapman to explicitly indicate that the count value is updated according to a value being dynamically calculated by accumulating a plurality of actual time intervals would not modify the invention of Chapman to perform correction outside of normal production testing. Therefore, since this aspect would not be modified the purpose of Chapman would not be destroyed by the combination.

The Examiner also notes that the further arguments presented with respect to the combination of Chapman and Progar have been considered but are not considered to be persuasive to the specific claimed limitations to overcome the outstanding rejection.


Examiner - AU 2857